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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,932	09/18/2003	Chris Kirmse	08226/1203348-US2	6591
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Yahoo! Inc. c/o DARBY & DARBY P.C. P.O. BOX 770 Church Street Station NEW YORK, NY 10008-0770			EXAMINER LIM, SENG HENG	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 08/15/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/665,932	<b>Applicant(s)</b> KIRMSE ET AL.	
	<b>Examiner</b> SENG H. LIM	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8-10,17-20,23,24,28-33 and 35-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 8-10, 17-20, 23-24, 28-33, 35-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 8-9, 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Danieli et al (US 7240093 B1) in view of Beuk et al (US 5,774,673).

Danieli et al discloses a game and messenger client server system, comprising: a plurality of game clients (5:28-30); a game server including logic to operate a multiplayer game using inputs from and outputs to an active game set of game clients including the plurality of game clients, wherein game clients other than those in the active game set can join an active game by supplying the game server with a reference to the active game (3:7-24); a plurality of messenger clients; a messenger server including logic to forward messages from a sender messenger client to a receiving messenger client; logic to couple a game client to a messenger client to allow the game client to send the messenger client data used to initiate joining a game, whereby a message sent by the messenger client includes the data used to initiate joining a game; and logic to initiate a join of a game at an invitee client, using data received in a message to the invitee (9:58-62; 3:10-4:10; Fig. 19, 9). The system further comprising an icon that indicates a state of an inviter client, wherein the icon is a game-specific icon (7:32-40). The game and messenger client server system further comprising logic to generate a data file sent in response to a request from the invitee client (9:58-62).

Danieli et al noted that the player does not need to have the gaming utility opened or launched in order to receive an invitation to join a game. The player only needs to have the MSN messenger open (14:32-35). With that in mind, Danieli et al does not disclose wherein the data in the message or invitation sent by the messenger

client comprises a command line executable for an invitee client to invoke the gaming client or utility to connect to the game server. Beuk et al discloses wherein the data in a message or invitation sent by a messenger client comprises a command line executable for an invitee client to execute or invoke a gaming client or application to connect to the game server (Abstract, 2:54-3:25, 9:21-28). Danieli et al and Beuk et al are analogous art because they are from the same field of endeavor of using a messaging client with a gaming client. At the time of invention a person of ordinary skill in the art would have found it obvious to modify Danieli et al's system to incorporate Beuk's method of invoking the gaming client with a start or joining message to connect to the game server and would have been motivated to do so to provide alternative ways to start a game.

**Claims 17-20, 23-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Danieli et al (US 7240093 B1) in view of Beuk et al (US 5,774,673).

Danieli et al discloses a method of operating a multi-player game having a plurality of game clients and a plurality of messenger clients, the plurality of game clients and plurality of messenger clients in communication with a game server and a messenger server (Fig. 1), the method comprising: joining the game by sending a reference to the game to the game server; sending, from an inviter game client to an inviter messenger client, data used to initiate joining the game; sending a message including the data used to initiate joining the game to the messenger server; routing the message to an invitee messenger client; and using the data in the routed message to invoke a game client and join the game. The method includes sending, from the game server to the inviter game client, a reference used to join the game; sending the message to a list of messenger clients associated with the inviter messenger client, wherein an updated state is perceptible by a user of the invitee messenger client; updating a state of an icon associated with the inviter messenger client in response to receiving the message; and sending a request for a game data file to the game server. The game data file includes a reference to the game locally (3:10-4:10).

Danieli et al noted that the player does not need to have the gaming utility opened or launched in order to receive an invitation to join a game. The player only

needs to have the MSN messenger open (14:32-35). With that in mind, Danieli et al does not disclose wherein the data in the message or invitation sent by the messenger client comprises a command line executable for an invitee client to invoke the gaming client or utility to connect to the game server. Beuk et al discloses wherein the data in a message or invitation sent by a messenger client comprises a command line executable for an invitee client to execute or invoke a gaming client or application to connect to the game server (Abstract, 2:54-3:25, 9:21-28). Danieli et al and Beuk et al are analogous art because they are from the same field of endeavor of using a messaging client with a gaming client. At the time of invention a person of ordinary skill in the art would have found it obvious to modify Danieli et al's system to incorporate Beuk's method of invoking the gaming client with a start or joining message to connect to the game server and would have been motivated to do so to provide alternative ways to start a game.

**Claims 28-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Danieli et al (US 7240093 B1) in view of Beuk et al (US 5,774,673).

Danieli et al discloses a method of operating a multi-player game having an inviter client, an invitee client, and a server, the method comprising: invoking an inviter game client at the inviter client; connecting the inviter game client to the game by sending a reference to the game to the server; creating a message at the inviter client containing data used for invoking an invitee game client and for joining the game; routing the message to the invitee client; and using the data in the message to invoke the invitee game client and join the game. Creating the message comprises of creating the message at the inviter client/server and routing the message by using TCP/IP (2:6-10). The message is sent to a second server (3:10-4:10).

Danieli et al noted that the player does not need to have the gaming utility opened or launched in order to receive an invitation to join a game. The player only needs to have the MSN messenger open (14:32-35). With that in mind, Danieli et al does not disclose wherein the data in the message or invitation sent by the messenger client comprises a command line executable for an invitee client to invoke the gaming client or utility to connect to the game server. Beuk et al discloses wherein the data in a

message or invitation sent by a messenger client comprises a command line executable for an invitee client to execute or invoke a gaming client or application to connect to the game server (Abstract, 2:54-3:25, 9:21-28). Danieli et al and Beuk et al are analogous art because they are from the same field of endeavor of using a messaging client with a gaming client. At the time of invention a person of ordinary skill in the art would have found it obvious to modify Danieli et al's method to incorporate Beuk's method of invoking the gaming client with a start or joining message to connect to the game server and would have been motivated to do so to provide alternative ways to start a game.

**Claim 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Danieli et al (US 7240093 B1) in view of Beuk et al (US 5,774,673).

Danieli et al discloses a game and messenger client server system, comprising: a plurality of game clients including an inviter and an invitee game client; a plurality of messenger clients including an inviter and invitee messenger client; a server including logic to operate a multiplayer game using inputs from and outputs to an active game set of game clients of the plurality of game clients, wherein game clients other than those in the active game set can join an active game by supplying the server with a reference to the active game (3:10-13, 10:43-48); logic to couple the inviter game client to the inviter messenger client to allow the inviter game client to send the inviter messenger client data used to initiate joining a game, whereby a message sent by the inviter messenger client includes the data used to initiate joining a game; and logic to initiate a join of a game at the invitee game client, using data received in a message to the invitee messenger client, wherein the inviter messenger client includes logic to forward messages to the invitee messenger client (3:25-53).

Danieli et al noted that the player does not need to have the gaming utility opened or launched in order to receive an invitation to join a game. The player only needs to have the MSN messenger open (14:32-35). With that in mind, Danieli et al does not disclose wherein the data in the message or invitation sent by the messenger client comprises a command line executable for an invitee client to invoke the gaming client or utility to connect to the game server. Beuk et al discloses wherein the data in a

message or invitation sent by a messenger client comprises a command line executable for an invitee client to execute or invoke a gaming client or application to connect to the game server (Abstract, 2:54-3:25, 9:21-28). Danieli et al and Beuk et al are analogous art because they are from the same field of endeavor of using a messaging client with a gaming client. At the time of invention a person of ordinary skill in the art would have found it obvious to modify Danieli et al's system to incorporate Beuk's method of invoking the gaming client with a start or joining message to connect to the game server and would have been motivated to do so to provide alternative ways to start a game.

**Claims 35-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Danieli et al (US 7240093 B1) in view of Beuk et al (US 5,774,673).

Danieli et al discloses a program and method for providing a multi user networked computing environment, the method using an activity server and a messenger server, where the activity server and the messenger server are configured to communicate with a plurality of user computer systems, the user computer system including an activity client where the user computer system executes a user interface operated by a human user and is further configured to engage an activity using the activity client, wherein the user interface includes a display device and a user input device, wherein the user computer system is coupled to a network for exchanging information with the activity server and the messenger server (Fig. 1, 6), the method comprising: accepting signals from the user input device to engage the activity or game using the activity or game client; presenting one or more preferences to the user computer system, where the one or more preferences are associated with activities or games; selecting at least one preference to join the activity or game; invoking the selected activity with a messenger client; providing to the messenger server a user state and a reference to the activity or game in which the user is participating; and presenting to another user associated with at least one of the plurality of user computer systems the user state and the reference to the activity or game (3:10-53).

Danieli et al noted that the player does not need to have the gaming utility opened or launched in order to receive an invitation to join a game. The player only

needs to have the MSN messenger open (14:32-35). With that in mind, Danieli et al does not disclose wherein the data in the message or invitation sent by the messenger client comprises a command line executable for an invitee client to invoke the gaming client or utility to connect to the game server. Beuk et al discloses wherein the data in a message or invitation sent by a messenger client comprises a command line executable for an invitee client to execute or invoke a gaming client or application to connect to the game server (Abstract, 2:54-3:25, 9:21-28). Danieli et al and Beuk et al are analogous art because they are from the same field of endeavor of using a messaging client with a gaming client. At the time of invention a person of ordinary skill in the art would have found it obvious to modify Danieli et al's system to incorporate Beuk's method of invoking the gaming client with a start or joining message to connect to the game server and would have been motivated to do so to provide alternative ways to start a game.

**Claims 40-51, 96-105** are rejected under 35 U.S.C. 103(a) as being unpatentable over Danieli et al (US 7240093 B1) in view of Beuk et al (US 5,774,673).

Danieli et al discloses logic and computer program product for use at an invitee client to initiate joining by an invitee game client to an active game that is hosted by a game server and to which an inviter game client is joined, the invitee client including an invitee messenger client for receiving in at least one message from an inviter messenger client data used to initiate joining a game, the logic comprising: invocation logic for using the data to invoke the invitee game client and connect the invitee game client to the game server, wherein the data includes a reference to the game server and a reference to the active game, the inviter and invitee game clients being respectively associated with the inviter and invitee messenger clients. The data used to initiate joining a game includes a game server network address that identifies the game server, a game identifier that identifies the active game on the identified game server, and a port identifier that identifies a port on the identified game server (3:10-13, 10:43-48). Danieli also discloses the logic for activating the invocation logic in response to action by a user (10:14-17); for displaying a buddy list of the invitee messenger client and an indication that the invitee game client may join an active game which a member of the



buddy list is playing (Fig. 8); for displaying a game-specific icon identifying the active game (Fig. 19); for use at an invitee client wherein the invitee messenger client is associated with a member of a buddy list of the inviter messenger client (Fig. 18); for use at an invitee client wherein the invitee messenger and game clients reside at a first computer system, and the inviter messenger and game clients reside at a second computer system (Fig. 1, 8, 14); for sending to other messenger clients at least one message including a reference to an active game (3:10-13, 45-50); for use at an invitee client wherein the invitee messenger client is operable to receive the at least one message inherently via a messenger server and to read at least one registry entry usable to invoke the invitee game client; for use at an invitee client wherein the invitee messenger client is operable to receive at least one message including a reference to a potential game (3:10-13, 45-50).

Danieli et al noted that the player does not need to have the gaming utility opened or launched in order to receive an invitation to join a game. The player only needs to have the MSN messenger open (14:32-35). With that in mind, Danieli et al does not disclose wherein the data in the message or invitation sent by the messenger client comprises a command line executable for an invitee client to invoke the gaming client or utility to connect to the game server. Beuk et al discloses wherein the data in a message or invitation sent by a messenger client comprises a command line executable for an invitee client to execute or invoke a gaming client or application to connect to the game server (Abstract, 2:54-3:25, 9:21-28). Danieli et al and Beuk et al are analogous art because they are from the same field of endeavor of using a messaging client with a gaming client. At the time of invention a person of ordinary skill in the art would have found it obvious to modify Danieli et al's logic to incorporate Beuk's logic of invoking the gaming client with a start or joining message to connect to the game server and would have been motivated to do so to provide alternative ways to start a game.

**Claims 52-95** are rejected under 35 U.S.C. 103(a) as being unpatentable over Danieli et al (US 7240093 B1) in view of Beuk et al (US 5,774,673).

Danieli et al discloses a logic with computer program product comprising program code and method of operating an invitee client to initiate joining by an invitee game client to an active game that is hosted by a game server and to which an inviter game client is joined, the invitee client including an invitee messenger client for receiving in at least one message from an inviter messenger client data used to initiate joining a game, the method comprising: invoking the invitee game client using the data; and connecting the invitee game client to the game server using the data, wherein the data includes a reference or identifier such as an IP address to the game server and a reference to the active game, the inviter and invitee game clients being respectively associated with the inviter and invitee messenger clients. User initiates joining to the active game in response to action by a user (3:10-13, 45-50, 10:43-48). The method further comprising displaying a buddy list of the invitee messenger client and an indication that the invitee game client may join an active game which a member of the buddy list is playing (Fig. 8). The method further comprising displaying a game-specific icon identifying the active game (Fig. 19). The invitee messenger client is associated with a member of a buddy list of the inviter messenger client (Fig. 18). The invitee messenger and game clients reside at a first computer system, and the inviter messenger and game clients reside at a second computer system (Fig. 1). The method further comprising sending to other messenger clients at least one message including a reference to an active game (3:10-13, 45-50, 10:43-48).

Danieli et al noted that the player does not need to have the gaming utility opened or launched in order to receive an invitation to join a game. The player only needs to have the MSN messenger open (14:32-35). With that in mind, Danieli et al does not disclose wherein the data in the message or invitation sent by the messenger client comprises a command line executable for an invitee client to invoke the gaming client or utility to connect to the game server. Beuk et al discloses wherein the data in a message or invitation sent by a messenger client comprises a command line executable for an invitee client to execute or invoke a gaming client or application to connect to the game server (Abstract, 2:54-3:25, 9:21-28). Danieli et al and Beuk et al are analogous art because they are from the same field of endeavor of using a messaging client with a

gaming client. At the time of invention a person of ordinary skill in the art would have found it obvious to modify Danieli et al's logic to incorporate Beuk's logic of invoking the gaming client with a start or joining message to connect to the game server and would have been motivated to do so to provide alternative ways to start a game.

Danieli does not expressly disclose validating the potential game as legitimate. Beuk et al discloses validating the potential game as legitimate by verifying with the activation unit (Abstract). At the time of invention a person of ordinary skill in the art would have found it obvious to incorporate the verification of the potential game as legitimate to make sure player's have legitimate games.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1, 17, & 33** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 & 13 of U.S. Patent No. 6699125 in view of Beuk et al (US 5,774,673). Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a method of operating a game and messenger client server system comprising of a plurality of game clients, a game server, plurality of messenger clients, a messenger server, and logic to couple game client to messenger client and initiate a join of a game at an invitee client. U.S. Patent No. 6699125's claims do not expressly disclose wherein the data in a message or invitation sent by a messenger client comprises a command line executable for an invitee client to execute or invoke a gaming client or application to connect to the game server; however Beuk et al discloses wherein the data in a message or invitation sent by a messenger client comprises a command line executable for an invitee client to execute or invoke a gaming client or application to connect to the game server (Abstract, 2:54-3:25, 9:21-28). U.S. Patent No. 6699125 and Beuk et al are analogous art because they are from the same field of endeavor of using a messaging client with a gaming client. At the time of invention a person of ordinary skill in the art would have found it obvious to modify U.S. Patent No. 6699125 system to incorporate Beuk's logic of invoking the gaming client with a start or joining message to connect to the game server and would have been motivated to do so to provide alternative ways to start a game.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached USPTO form PTO-892.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SENG H. LIM whose telephone number is (571)270-3301. The examiner can normally be reached on 9:30-6:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. H. L./

Examiner, Art Unit 3714

August 12, 2008

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3714